

## **REMARKS**

The Examiner, Mr. Berman, is thanked for the courtesy extended applicants attorney during the telephone discussion of December 14, 2006 concerning the finality of the first office action in response to an RCE, in which the Amendment filed July 31, 2006 in response to the final office action was denied entry as not placing the application in better form for appeal by materially reducing or simplifying the issues for appeal. As pointed out to the Examiner, while the Examiner has maintained the same position concerning the cited art, as previously set forth, regarding the amendment which was denied entry, the issuance of a final office action in response to the filing of the RCE, which was required in order to obtain consideration of the Amendment could be considered to be inappropriate in precluding amendments of a clarifying nature. The undersigned attorney explained that the Amendments to the claims, as presented herein, are of a clarifying nature to independent claims 5 and 6 to clarify the feature as noted in the office action by the Examiner that "it is this feature of displaying both the wafer map and defect image on the same screen that applicant points to in order to distinguish the claimed invention over the prior art." (emphasis added). The Examiner indicated that amendment of claims 5 and 6 to clarify such feature, would be permitted entry at this time.

Accordingly, by the present amendment, independent claims 5 and 6 have been amended to recite the feature that the selected one of the actual images is displayed together with said map format on said screen noting that claim 5 recites "stored actual images". Accordingly, in view of the discussion with the Examiner, it is assumed that such amendment will be entered.

Applicants note that although not discussed with the Examiner, applicants have only recently discovered that one of the inventors of the present application is a co-inventor of a previously filed copending application directed to related subject matter. Accordingly, also by the present amendment, the specification has been amended to set forth a cross reference to related application and designate the present application as a continuation-in-part application of US Application Serial No. 09/450,856, filed November 29, 1999, now US Patent No. 6,476,913. Since this relationship was only recently discovered, and in accordance with the requirements of 37 CFR §1.78, a Petition to Accept an Unintentionally Delayed Claim under 35 USC 120, is also being filed herewith together with the appropriate fee, and it is expected that the petition will be granted.

As to the rejection of claims 3, 5, 6, 12 - 16 and 25 - 30 under 35 USC 103(a) as being unpatentable over Mizuno in view of Hardikar et al, and the rejection of claims 10, 11 and 20 - 24 under 35 USC 103(a) as being unpatentable over Mizuno in view of Hardikar and Gallarda, such rejections are traversed insofar as they are applicable to the present claims and reconsideration and withdrawal of the rejections are respectfully requested.

As to the requirements to support a rejection under 35 USC 103, reference is made to the decision of In re Fine, 5 USPQ 2d 1596 (Fed. Cir. 1988), wherein the court pointed out that the PTO has the burden under '103 to establish a prima facie case of obviousness and can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. As noted by the court, whether a particular combination might be

"obvious to try" is not a legitimate test of patentability and obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. As further noted by the court, one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

Furthermore, such requirements have been clarified in the decision of In re Lee, 61 USPQ 2d 1430 (Fed. Cir. 2002) wherein the court in reversing an obviousness rejection indicated that deficiencies of the cited references cannot be remedied with conclusions about what is "basic knowledge" or "common knowledge".

The court pointed out:

The Examiner's conclusory statements that "the demonstration mode is just a programmable feature which can be used in many different device[s] for providing automatic introduction by adding the proper programming software" and that "another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial" do not adequately address the issue of motivation to combine. This factual question of motivation is immaterial to patentability, and could not be resolved on subjected belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher."... Thus, the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion. (emphasis added)

In setting forth the rejection, the Examiner states:

Applicant appears to admit that both Mizuno and Hardikar et al display both images of defects and wafer maps showing the locations of defects, but argues that neither reference suggests display both wafer maps and a selected one of the stored actual images of defect candidates on the same screen. Instead, they both display the wafer

map and defect image on separate screens. It is this feature of displaying both the wafer map and defect image on the same screen that applicant points to in order to distinguish the claimed invention over the prior art. However, this is merely a change in the format in which the images are displayed and has no functional significance since no additional information about the wafer being inspected is generated. Since both Mizuno and Hardikar et al teach to display both a wafer map and defect images it would have been obvious to a person having ordinary skill in the art to arrange these displays in any format that such a person found to be convenient, including on the same screen. (emphasis added).

At the outset, applicants note that the Examiner's characterization of applicants argument regarding "on the same screen" may be a mischaracterization of applicants argument. More particularly, the presently claimed invention is directed the display of both the wafer map and a selected one of the stored actual defect images together on the same screen. That is, as shown in Fig. 8 of the drawings of this application and as described in the specification, the wafer map is displayed in the map display portion 55 of the screen and the current location symbol 59 is moved over a defect indicated in the wafer map displayed in the map display portion 55 of the screen, and upon selection of such defect, the actual image of the selected defect is displayed together with the wafer map in the image display portion 56 of the same screen, noting that this feature has been previously set forth in claim 16, in reciting the step of simultaneously displaying on the screen a selected one of the stored actual images of the detected defect candidates stored in the memory which is designated on the screen among the defect candidate data displayed in the map format on the screen. By the present amendment, claims 5 and 6 have been amended to clarify such feature in reciting that the selected one of the actual images is displayed together with the map format on the screen. Thus, two specific types of information, as claimed, are displayed together on the same screen, and as

recognized by the Examiner, neither Mizuno nor Hardikar et al provide any disclosure regarding such feature.

Turning to Mizuno, while Mizuno describes obtaining actual images of defects and displaying a wafer map thereof, as illustrated in Fig. 6A thereof, Mizuno provides no disclosure or teaching of displaying an actual image of a defect indicated on the wafer map together with the wafer map on the same screen. That is, Mizuno discloses classification of effects and displaying a symbol indicative of the classified defect on the wafer map, as illustrated in Fig. 6B, but hereagain, provides no disclosure or teaching of selecting a defect indicated on the wafer map, and, in addition to displaying the wafer map, displaying the selected actual image of the defect together with the wafer map on the same screen. Thus, it is apparent that the Examiner has engaged in a hindsight reconstruction attempt utilizing the principle of “obvious to try” which is not the standard of 35 USC 103. See In re Fine, supra. Further, the Examiner’s position also represents utilizing what applicant has taught against the teacher which is also not proper. See, In re Lee, supra.

Turning to Hardikar et al, applicants submit that Hardikar et al does not overcome the deficiencies of Mizuno, as pointed out above. Applicants note that Fig. 6C of Hardikar et al discloses display of a wafer map 681 together with display of other information, such as defect classification by color coding in accordance with the drop down list box 682, for example. Thus, this information corresponds somewhat to the information as displayed in Fig. 6B of Mizuno. While Figs. 6D and 6E of Hardikar et al show different types of information which can be displayed, there is no disclosure or teaching in Hardikar et al of displaying an actual image of a defect, which is designated on the map format display, together with the map format

display, as recited in the claims of this application. Accordingly, applicants submit that Hardikar et al provides no disclosure or teaching that, in addition to displaying on a screen defect candidate data in map format, there is also displayed on the screen a selected one of the actual images of the stored defects which is designated on the screen among the defect candidate data displaying the map format on the screen together on the same screen, with the attendant advantages as described in the specification of this application. Thus, applicants submit that Hardikar et al fails to overcome the deficiencies of Mizuno, and the suggested combination does not provide the claimed features, which fact is apparent recognized by the Examiner by the Examiner's statement "it would have been obvious to a person having ordinary skill in the art to arrange these displays in any format that such a person found to be convenient, including on the same screen." (emphasis added). Again, the Examiner has engaged in a hindsight reconstruction attempt utilizing what applicant has taught against the teacher. Accordingly, applicants submit that all claims patentably distinguish over this proposed combination of references in the sense of 35 USC 103 and should be considered allowable thereover.

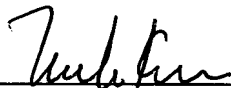
As to the addition of Gallarda, whether or not Gallarda may be considered to disclose utilizing different thresholds for defect detection, Gallarda also fails to disclose or teach displaying on the screen defect candidate data in a map format and also displaying on a screen, a selected one of the actual images of the defect candidates which is designated on the screen among the defect candidate data displayed in the map format on the screen so that the map format and the actual image of the designated defect candidate are displayed together on the same screen. Accordingly, applicants submit that Gallarda also fails to overcome the

deficiencies of Mizuno and Hardikar et al and the resultant combination fails to provide the claimed features as set forth in the claims of this application in the sense of 35 USC 103.

In view of the above amendments and remarks, applicants submit that all claims present in this application patentably distinguish over the cited art in the sense 35 USC 103, and all claims should now be in condition for allowance.

To the extent necessary, applicant's petition for an extension of time under 37 CFR 1.136. Please charge any shortage in the fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 01-2135 (501.41125X00) and please credit any excess fees to such deposit account.

Respectfully submitted,



Melvin Kraus  
Registration No. 22,466  
ANTONELLI, TERRY, STOUT & KRAUS, LLP

MK/jla  
(703) 312-6600